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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,431	10/14/2003	Dale W. Malik	190250-1590	7278
83658 7590 09/30/2009 AT & T Legal Department - WS Attn: Patent Docketing Room 2A-207 One AT & T Way Bedminster, NJ 07921				
EXAMINER				
CHANG, JUNGWON				
ART UNIT		PAPER NUMBER		
2454				
MAIL DATE		DELIVERY MODE		
09/30/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/686,431

**Applicant(s)**

MALIK ET AL.

**Examiner**

JUNGWON CHANG

**Art Unit**

2454

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This action is in response to RCE filed on 8/26/09. Claim 21 has been canceled. Claims 1-20 and 22 are presented for examination.

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/26/09 has been entered.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-20 and 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-20 and 22 are broad enough to read on performing the steps which do not involve using a machine, manufacture, or composition of matter. The claims are directed to software per se, which are not statutory subject matter. The Specification on page 10, lines 10-18 states that:

Regardless of whether the various components 104, 106, 108, 110 are launched as software modules or instantiated as distributed objects, once the various components 104, 106, 108, 110 are running as background processes, the tray manager 102 launches a user interface (not shown), which requests the user to select either an IM interface (not shown in FIG. 1) or an email interface (not shown in FIG. 1). FIGS. 2A through 2C are block diagrams showing component architecture associated with the user selecting the email interface (not shown in FIG. 1), while FIGS. 3A through 3C are block diagrams showing component architecture associated with the user selecting the IM interface (not shown in FIG. 1).

The recited method (claims 1-8), means for (claim 9), logic (claims 10-13), and code (claims 14-20 and 22) are software per se, which are not statutory subject matter.

Please see MPEP § 2106.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein et al, (US 2004/0128356), hereinafter Bernstein, in view of Beyda (US 2003/0229670), Szeto et al, (US 7,406,501), hereinafter Szeto.

7. As to claims 1, 9 and 10, Bernstein discloses the invention as claimed, including method comprising the steps of:

determining an Internet presence of a contact identified in an email message (page 2, 0016-0017, "presence detection by sending...email invitation"; page 1, 0007, "particular user's presence online...presence detection"),

wherein the determining comprises comparing an email address of the contract identified to an address book database (page 7, 00124-0131, "compares the source of the email against...list of acceptable senders"); and

initiating, by the instant messaging client (instant messaging application) an instant messaging (IM) chat session with the contact in response to determining that the contact is present (page 1, 0007; page 4, 0064, "each recipient is sent an instant message invitation email message").

8. Although Bernstein discloses determining an internet presence of a contact, Bernstein does not specifically disclose the presence of the contact is determined by an instant messaging client. Beyda discloses the presence of the contact is determined by an instant messaging client (120, fig. 6; page 2, 0022, "user's online presence may still be detected or monitored by an instant messaging system"; 0029, "instant messaging server, service or system and thereby capable of detecting or monitoring the online presence"). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Bernstein and Beyda because Beyda's teaching would allow a user to be notified of the presence of the intended recipient, as taught by Beyda (page 1, 0004-0005).

9. Bernstein does not specifically disclose retrieving an instant messaging address of the contact identified from the address book databases, and then using the retrieved instant messaging address to determine that the contact is present. Szeto discloses

retrieving an instant messaging address of the contact identified (402, fig. 4) from the address book databases (400, fig. 4) (co. 10, lines 4-62), and then using the retrieved instant messaging address to determine that the contact is present (204, 206, fig. 2; 312, fig. 3; col. 7, lines 16-39). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Bernstein and Szeto because Szeto's teaching would provide an accurate indication of whether the retrieved instant messaging address is currently online or offline, as taught by Szeto (col. 7, lines 16-39).

10. As to claims 2-8, Bernstein discloses, wherein the step of initiating the IM chat session comprises the steps of: generating an IM chat window; obtaining information from the email message; and displaying the obtained information in the generated IM chat window (page 2, 0023, "IM area"; page 5, 0093-0100, "display to the user").

11. As to claims 11-13, they are rejected for the same reasons set forth in claims 2-8 above. In addition, Bernstein discloses computer-readable code (page 3, 0052-0053).

12. As to claim 14, it is rejected for the same reasons set forth in claim 1 above. In addition, Bernstein discloses computer-readable code (page 3, 0052-0053).

13. As to claims 15-19 and 22, they are rejected for the same reasons set forth in claims 1-8 above. In addition, Bernstein discloses computer-readable code (page 3,

0052-0053).

14. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein et al, (US 2004/0128356), hereinafter Bernstein, in view of Beyda (US 2003/0229670), Szeto et al, (US 7,406,501), hereinafter Szeto, further in view of Dalal et al, (US 2002/0065894), hereinafter Dalal.

15. Bernstein discloses displaying the obtained information in the generated IM chat window (page 2, 0023, "IM area"; page 5, 0093-0100, "display to the user"). However, Bernstein does not specifically disclose providing the body of the email message as an IM chat message. Dalal discloses providing the body of the email message as an IM chat message (page 3, 0024, "the body of the email reply becomes the text content of the instant messaging"). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Bernstein and Dalal because Dalal's teaching would reduce the time to generate an instant message which has correlation information with the email message, as taught by Dalal (page 3, 0024).

16. Applicant's arguments with respect to claims 1-20 and 22 have been considered but are moot in view of the new ground(s) of rejection.

17. The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure:

Parker et al, US 7,379,704, Tomabene et al, US 2002/0023132, Sumner et al, US 2002/0061003 discloses a contact block identifies modes of communication such as email, instant message, video conferencing, threads, telephone, and the like.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUNGWON CHANG whose telephone number is (571)272-3960. The examiner can normally be reached on M-F 6:30 - 2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JUNGWON CHANG/  
Primary Examiner, Art Unit 2454  
September 28, 2009